

## **REMARKS**

In the Office Action dated December 22, 2004, the Examiner rejected claims 1-16, 21-33, 38, and 39 under 35 U.S.C. § 101; rejected claims 1, 2, 5-13, 15-22, and 24-39 under 35 U.S.C. § 103(a) as being unpatentable over *Flaig et al.* (U.S. Patent No. 6,488,206) in view of *Hall III et al.* (U.S. Patent No. 6,158,657); and rejected claims 3, 4, 14, and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Flaig et al.* in view of *Walker et al.*

By this Amendment, Applicants amend claims 1-39. As such, with entry of this amendment, claims 1-39 remain pending in this application. Based on the following remarks, Applicants respectfully traverse the above rejections under 35 U.S.C. §§ 101 and 103(a).

### **I. The Rejections of Claims 1-16, 21-33, 38, and 39 under 35 U.S.C. § 101**

The Examiner asserts that claims 1-16, 21-33, 38, and 39 recite non-statutory subject matter because claims 1, 12, and 21 “recite an abstract idea.” (See *Office Action*, page 4, lines 7-8.) In particular, the Examiner asserts that the recitations of these claims can be performed in the mind of a user or by pencil and paper.

Although Applicants disagree with the Examiner’s interpretation of these claims, Applicants have amended claims 1, 12, and 21 to address the Examiner’s concerns. Because amended claims 1-16, 21-33, 38, and 39 are directed to the technological arts and recite non-abstract statutory subject matter, Applicants respectfully request that the Examiner withdraw the rejection of these claims under 35 U.S.C. § 101.

**II. The Rejections of Claims 1, 2, 5-13, 15-22, and 24-39 under  
35 U.S.C. § 103(a)**

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03.

Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

**a. Claim 1**

**(i) The cited art, alone or in combination, do not teach or suggest at least generating a second risk splitting question and determining a credit limit, as recited in claim 1.**

In an effort to reject claim 1, the Examiner asserts *Flaig et al.* teaches, among other things, “requiring the applicant to answer at least a first risk-splitting question and second risk-splitting question . . . based on a reply to the first risk splitting question.” (See *Office Action*, p. 5, lines 3-5.) The Examiner further asserts that *Flaig et al.* “utilizes multiple questions in sequence and based on any of them having satisfied the requisite criteria, the activation process is terminated.” (See *Office Action*, p. 2, lines 14-16.) Applicants respectfully disagree with the Examiner’s interpretation of *Flaig et al.*

*Flaig et al.* discloses a system for detecting fraudulent transactions in credit card activations. The system verifies the authenticity of an activation sequence by

presenting queries to the person requesting activation for a particular card. The queries may include a request for the credit card number followed by addition identification information, such as name, pin numbers, passwords, etc. (See *Flaig et al.* col. 5, lines 3-26.) As correctly pointed out by the Examiner, incorrect responses to the queries may result in termination of the activation process. *Flaig et al.*, however, does not teach or suggest generating a second risk splitting question, based on the first response, for provision to the applicant, where the second risk splitting question is configured to elicit additional information regarding subject matter associated with the first response, as recited in claim 1. In fact, the Examiner does not address these recitations of claim 1, nor the arguments associated with these recitations presented by Applicants in the Amendment filed September 21, 2004. (See Amendment filed Sept. 21, 2004, page 13, lines 11-13.) Instead, the Examiner merely concludes the cited art discloses first and second risk splitting questions without discussing or pointing to where the references disclose the configuration of a second splitting question as recited in claim 1.

Additionally, as admitted by the Examiner, *Flaig et al.* does not teach determining a credit limit based on an applicants answers to risk splitting questions. In an attempt to make up for this deficiency of *Flaig et al.* (the Examiner does not address the first deficiency of *Flaig et al.*), the Examiner cites to *Hall et al.* In particular, the Examiner asserts that *Hall et al.* teaches the determination of a credit limit "based on credit history and earning capacity." (See *Office Action*, p. 5, lines 8-10.) In response to Applicants arguments that *Hall et al.* failed to teach a credit limit based on risk splitting questions, the Examiner asserts that "Hall teaches the use of a secondary risk analysis to further evaluate a customer's risk prior to activation of a credit card product (column 11, line

44-column 12, line 10)." (See *Office Action*, p. 2, lines 17-20.) This, however, fails to bolster any position that *Hall et al.* does indeed teach or suggest determining a credit limit based on risk-splitting questions. Indeed, the "secondary risk analysis" performed by *Hall et al.* is merely an analysis associated with credit scores, etc. that are known in the credit card industry. Nowhere does *Hall et al.* disclose risk-splitting questions, much less using responses to these questions to determine a credit limit, as recited in claim 1.

Because, as admitted by the Examiner, *Flaig et al.* fails to teach these recitations, and as explained above, *Hall et al.* is equally deficient to support the Examiner's assertions regarding these recitations, the Examiner has failed to establish a *prima facie* case of obviousness.

**(ii) The Examiner's response to Applicants' arguments for lack of motivation to combine the cited art is misguided**

The Examiner asserts that Applicants' argument presented in the Amendment filed September 21, 2004 attacked the "references individually." (See *Office Action*, p. 3, lines 7-9.) Applicants disagree. In fact, as argued above, Applicants specifically addressed the deficiencies of *Flaig et al.* and *Hall et al.*, individually and in combination. For instance, in the September 21<sup>st</sup> Amendment, Applicants argued:

Combining *Flaig* with *Hall* would not have led to the claimed invention because *Flaig* and *Hall*, either individually or in combination, at least do not teach or suggest: i) requiring the applicant to answer at least a first risk-splitting question and a second risk-splitting question, the second risk-splitting question being based on a reply to the first risk-splitting question, wherein the second risk-splitting question is configured to elicit detailed information regarding subject matter associated with the first risk-splitting question; or ii) determining a credit limit for the applicant based on the applicant's answers to the risk-splitting questions, as recited by independent Claim 1. Independent Claims 12, 17, 19, and 21 each include a similar recitation. Accordingly,

independent Claims 1, 12, 17, 19, and 21 patentably distinguish the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claims 1, 12, 17, 19, and 21.

(See *Amendment Filed September 21, 2004*, page 14.)

As previously explained, *prima facie* obviousness has not been established at least because the requisite motivation to combine *Flaig et al.* and *Hall et al.* is lacking. Determinations of obviousness must be supported by evidence in the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). Further, the desire to combine references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show that a skilled artisan considering *Flaig et al.* and *Hall et al.*, and not having the benefit of Applicants' disclosure, would have been motivated to combine or modify the references in a manner resulting in Applicants' claimed combination. The Examiner alleges that a skilled artisan would have modified *Flaig et al.* because "Hall is evidence that one of ordinary skill in the art would recognize that a cardholder's credit limit is based on applicant's answers to certain relevant financial questions that determine the cardholder's 'spending power'." (See *Office Action*, page 5, lines 10-13.) This conclusion is not properly supported and does not show that a skilled artisan would have combined the references as alleged. The mere fact that *Hall et al.* mentions processes for determining credit worthiness does not show that a skilled artisan would have been motivated to modify *Flaig et al.* as

alleged, especially in light of the deficiencies of *Flaig et al.* regarding risk-splitting questions.

The M.P.E.P. makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” M.P.E.P. § 2143.01 (citations omitted). The Examiner has not shown that the cited art “suggests the desirability” of the alleged combination. Indeed, there is no reason why a skilled artisan would look to modify the credit card activation processes disclosed *Flaig et al.* with the credit worthiness determinations as disclosed by *Hall et al.* because in *Flaig et al.*, the accounts are already established, and, thus, there is no need in the *Flaig et al.* system to analyze credit worthiness when activating the credit cards. Therefore, the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, were improperly developed by using the teachings of the present application in hindsight to reconstruct the prior art. For at least these additional reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claim 1, and, thus, the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn.

For at least the foregoing reasons, *Flaig et al.* and *Hall et al.*, alone or in combination, fail to support the rejection of claim 1 under 35 U.S.C. § 103(a). Accordingly, Applicants request the withdrawal of the rejection and the timely allowance of the claim.

b. Claims 2, 5-11, 30, and 31

Claims 2, 5-11, 30, and 31 depend from claim 1. As explained, claim 1 is distinguishable from the cited art. Accordingly, claims 2, 5-11, 30, and 31 are also distinguishable from the cited art for at least the same reasons set forth in connection with claim 1. Further, the cited art fails to disclose or suggest the recitations of these claims.

For instance, contrary to the Examiner's assertions, *Flaig et al.* does not teach risk splitting questions including one of "asking the applicant for the applicant's gross annual income, asking the applicant if the applicant has a car, asking the applicant if the applicant has a checking account, asking the applicant if the applicant owns a residence, asking the applicant for the applicant's monthly housing or rent payment, asking the applicant if the applicant has a car loan, or asking the applicant how many credit cards the applicant has," as recited in claim 31. In fact, the Examiner cites "(column 11, line 44-column 12, line 10)." of *Flaig et al.* to support these assertions. This reference, however, was issued with only ten columns of text. In any event, *Flaig et al.* nowhere discloses the recitations of claim 31. Accordingly, the rejection of claim 31 are improper. Further, *Hall et al.* also does not support the Examiner's assertions. Indeed, column 11 to column 12 of *Hall et al.* discloses credit qualification criteria processes; none of which mention or suggest risk splitting questions, as recited in claim 31.

Accordingly, because the cited art does not support the rejection of claims 2, 5-11, 30, and 31, Applicants request that the rejection of these claims be withdrawn and the claims allowed.

c. Claims 12, 17, 19, and 21

The Examiner rejects independent claims 12, 17, 19, and 21 for the same reasons set forth in connection with claim 1. (See *Office Action*, p. 5, line 1.). As explained, claim 1 is distinguishable from *Flaig et al.* and *Hall et al.* Claims 12, 17, 19, and 21, while having a different scope, recite features similar to claim 1. Accordingly, claims 12, 17, 19, and 21 are distinguishable from the cited art for at least the same reasons set forth above in connection with claim 1. Therefore, Applicants request that the rejection of these claims be withdrawn and the claims allowed.

d. Claims 13, 15, 16, 18, 20, 22, 24-29, and 32-39

Claims 13, 15, 16, 32, and 33 depend from claim 12; claims 18, 34, and 35 depend from claim 17; claims 20, 36, and 37 depend from claim 19; and claims 22, 24-29, 38, and 39 depend from claim 21. As explained, claims 12, 17, 19, and 21 are distinguishable from the cited art. Accordingly, claims 13, 15, 16, 18, 20, 22, 24-29, 32-39 are also distinguishable from the cited art for at least the same reasons set forth in connection with independent claims 12, 17, 19, and 21. Further, because claims 33, 35, 37, and 39 recite, in various combinations, recitations similar to those of claim 31, they are distinguishable from *Flaig et al.* and *Hall et al.* for at least the same reasons set forth above in connection with claim 31. Therefore, Applicants request that the rejection of claims 13, 15, 16, 18, 20, 22, 24-29, and 32-39 be withdrawn and the claims allowed.

**III. The Rejections of Claims 3, 4, 14, and 23 under 35 U.S.C. § 103(a)**

Claims 3, 4, 14, and 23 depend from one of claims 1, 12, and 21, which were rejected under 35 U.S.C. § 103(a) in view of *Flaig et al.* and *Hall et al.* Accordingly, the

Examiner's rejection of dependent claims 3, 4, 14, and 23 in view of *Flaig et al.* and *Walker et al.* is improper. In particular, because claims 3, 4, 14, and 23 include the recitations of their respective base claims, these claims should at least be rejected using the same art cited in rejecting the base claims (i.e., *Flaig et al.* and *Hall et al.*). If the Examiner is substituting *Walker et al.* for *Hall et al.* to make up for the deficiencies of *Flaig et al.* (e.g., those deficiencies discussed above in connection with Applicants response to the reject of claim 1), such intentions is not articulated in the Office Action. Accordingly, Applicants assume the Examiner intended to reject claims 3, 4, 14, and 23 in view of *Flaig et al.* and *Hall et al.*, and *Walker et al.*, and respond accordingly. If the Examiner is taking a different position with respect to the alleged teachings of *Walker et al.* and *Flaig et al.*, Applicants respectfully request that the Examiner set forth the assertions in a new non-final Office Action.

Claims 3, 4, 14, and 23 depend from claims 1, 12, and 21, respectively. As explained, claims 1, 12, and 21 are distinguishable from *Flaig et al.* and *Hall et al.* Accordingly, claims 3, 4, 14, and 23 are also distinguishable from the cited art for at least the same reasons set forth in connection with claims 1, 12, and 21. Therefore, Applicants request that the rejection of these claims be withdrawn and the claims allowed.

III. Conclusion

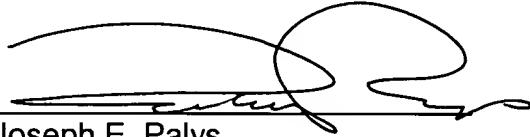
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 21, 2005

By: 

Joseph E. Palys  
Reg. No. 46,508